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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,491	10/12/2001	Michael C. Dorsey	2070.006600	3415

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B. Noel Kivlin
Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.
P.O. Box 398
Austin,, TX 78767-0398

EXAMINER

TRIMMINGS, JOHN P

ART UNIT PAPER NUMBER

2133

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

Office Action Summary	Application No.		Applicant(s)	
	09/976,491		DORSEY, MICHAEL C.	
	Examiner		Art Unit	
	John P Trimmings		2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,8-12,17,18,20-22 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8-12,17,18,20-22 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 1,3,6,9-12,17,22,25 and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/18/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/26/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the applicant's amendment dated 6/18/2004.

Claims 2, 4, 7, 13-16, 19, 23, 24 and 29-32 were cancelled by the applicant.

Claims 1, 3, 6, 8-12, 17, 18, 22, 25 and 28 were amended by the applicant.

Claims 1, 3, 5, 6, 8-12, 17, 18, 20-22 and 25-28 are pending in this office action.

Response to Amendment

1. In view of the applicant's corrections, the examiner withdraws the objection to the drawings.
2. In view of the applicant's corrections, the examiner withdraws the objection to the Specification.
3. In view of the applicant's corrections to Claims 1 and 17, the examiner withdraws the objection to these claims.
4. In view of the applicant's corrections, the examiner withdraws the rejection of Claims 7 and 28 under 35 USC 112 first and second paragraphs.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 5, 6, 8-12, 17, 18, 20-22 and 25-28 have been considered but are moot in view of the new grounds of rejection (see below).

Claim Objections

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5. Claims 1, 3, 6, 9, 10, 11, 12, 17, 22, 25, 26 and 27, objected to because of the following informalities:

As per Claims 1, 3, 6, 9, 10, 11, 12, 17, 25, 26 and 27:

See 37 CFR 1.75 and MPEP § 608.01(m). The claims must commence on a separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP.

As per Claim 10:

The examiner believes lines 8 and 12 should recite, "the memory built-in self-test state machine".

As per Claim 12:

The examiner believes lines 8 and 11 should recite, "the memory built-in self-test engine".

As per Claim 22:

The examiner believes line 11 should recite, "[the] a logic built-in self-test engine".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 3, 5, 6, 8-12, 17, 18, 20-22 and 25-28 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

As per Claims 1, 17, and 22:

The addition in the applicant's amendment of the limitation, "step to a new scan chain", brings a new scope to the claims that the examiner, being one with ordinary skill in the art, has not been able to find within the disclosure. The literal interpretation of this limitation leads the examiner to the assumption that there are multiple scan chains (the limitation steps to a new one), and that the method/apparatus in the said claims sequences to each of these scan chains. The examiner has not found within the disclosure any reference such a concept as, "stepping to new scan chains". Found in the disclosure only, was a method "step" without any reference to "new scan chains". Therefore, the examiner is unable to use such a limitation in the claims in any manner that would carry out the applicant's invention. And since Claims 3, 5, 6, 8-12, 18, 20, 21 and 25-28 are dependent on Claims 1, 17 and 22, the Claims 3, 5, 6, 8-12, 18, 20, 21 and 25-28 are also rejected under 35 USC 112 first paragraph.

In all, Claims 1, 3, 5, 6, 8-12, 17, 18, 20-22 and 25-28 are rejected under 35 USC 112 first paragraph.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Trimmings whose telephone number is 703-305-0714. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Trimmings
Examiner
Art Unit 2133

jpt



ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100